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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,857	11/16/2000	William L. Jansen	24349-010	5894
7590 07/23/2009				
R Lewis Gable Cowan Liebowitz & Latman PC 1133 Avenue of the Americas New York, NY 10036-6799			EXAMINER VAN BRAMER, JOHN W	
			ART UNIT 3622	PAPER NUMBER
			MAIL DATE 07/23/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/714,857

**Applicant(s)**

JANSEN ET AL.

**Examiner**

JOHN VAN BRAMER

**Art Unit**

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**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 52-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 52-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No./Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 29, 2009 has been entered.

### ***Response to Amendment***

2. The amendment filed on April 29, 2009 cancelled all previously pending claims (Claims 1, 8, 14, 15, 18, 20, 23, 25-51). New claims 52-61 were added were amended. Thus, the currently pending claims considered below are Claims 52-61.

### ***Claim Rejections - 35 USC § 101***

3. Claims 52-56 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450

U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the method steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing. There is merely an indication that a user is interacting with a computer system and the computer system is merely transmitting, receiving and displaying data. The act of transmitting, receiving and displaying data is considered "insignificant extra solution activity" and as such does not satisfy the requirements of 35 U.S.C. 101.

***Claim Rejections - 35 USC § 112***

4. The amendment filed on April 29, 2009 has cancelled all previously pending claims. Thus, the 35 U.S.C. 112, second paragraph rejection detailed in the Office Action dated December 8, 2006 is withdrawn.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1, 8, 14, 15, 18, 20, 23, and 25 - 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Postrel (6,594,640).

Claims 52 and 57: Postrel discloses a method and system of tracking a user's loyalty program award point balance in a plurality of loyalty programs, comprising the steps of:

- a. Entering by a user into a computer system information identifying each of a plurality of loyalty programs in which the user is a participating member. (Col 4, lines 6-20 and Col 6, lines 1-40)

b. Obtaining by the computer system, for each of the identified loyalty programs, the number of points the user has available in the respective loyalty program, the number of points being obtained from a system of the respective loyalty program.

(Col 4, lines 6-20 and Col 6, lines 1-40)

c. Displaying to the user by the computer system the number of points available for each identified loyalty program. (Col 4, lines 6-20 and Col 6, lines 1-40)

Claims 53 and 58: Postrel discloses the method of claim 52 and the system of claim 57, further comprising storing on a central system the obtained number of points the user has available in each of the loyalty programs, the central system being different than the systems of any of the loyalty programs. (Col 4, lines 6-20 and Col 6, lines 1-40)

Claims 54 and 59: Postrel discloses the method of claim 52 and the system of claim 57, further comprising updating, by user request or action, the number of points the user has available in each of the loyalty programs. (Col 4, lines 6-20 and Col 6, lines 1-40 and Col 7, lines 1-41)

Claims 55 and 60: Postrel discloses the method of claim 52 and the system of claim 57, wherein obtaining comprises obtaining in real-time from systems of loyalty programs the number of points the user currently has available in each of the loyalty programs. (Col 4, lines 6-20; Col 6, lines 1-40 and Col 7, lines 1-41)

Claims 56 and 61: Postrel discloses the method of claim 52 and the system of claim 57, further comprising enabling the user to add additional loyalty programs into the computer system and to remove loyalty programs from the computer system. (Col 4, lines 6-20; Col 6, lines 1-40 and Col 7, line 42 through Col 8, line 3)

### ***Response to Arguments***

8. Applicant's arguments filed April have been fully considered but they are not persuasive. The arguments directed toward the newly submitted claims and the amended claims have been addressed in the Office Action above. However, in an effort to further the prosecution of the case the examiner would like to direct the applicants attention to Fig. 4 and Col 6, line 1-52 which discloses a user viewing his account information and interactively (Col 6, line 22) interactively choosing which accounts to debit and/or credit points to or from. Thus, there is more than one account total displayed.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN VAN BRAMER whose telephone number

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is (571)272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John Van Bramer/  
John Van Bramer  
Examiner, Art Unit 3622